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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,515	10/07/2004	Guglielmo Biagiotti	6390/PCT	8896
6858 7590 05/16/2007 BREINER & BREINER, L.L.C. P.O. BOX 19290 ALEXANDRIA, VA 22320-0290			EXAMINER MACKEY, JAMES P	
			ART UNIT 1722	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/510,515	<b>Applicant(s)</b> BIAGIOTTI ET AL.	
	<b>Examiner</b> James Mackey	<b>Art Unit</b> 1722	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
     4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/7/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. Applicant's election of Group I, claims 1-4 in the reply filed on 20 April 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 5-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 20 April 2007.

3. Applicant should update the Title to describe the elected invention (e.g., apparatus only).

4. Figures 2 and 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The abstract of the disclosure is objected to because of the inclusion of the legal phraseology "said", and because of the misnumbering "83)" and "87)". Correction is required. See MPEP § 608.01(b).

Applicant should provide a new abstract on a separate sheet.

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means"

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and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 15, "said first lamination and ply-bonding nip" lacks clear antecedent basis in the claim; line 16, "the fibers" lacks antecedent basis in the claim; and lines 16-17, "said two previously laminated and ply-bonded layers" lacks clear antecedent basis in the claim.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Riemersma et al. (U.S. Patent 4,272,473; Figure 1).

Riemersma et al. teach an embossing apparatus comprising a first rigid cylinder 17 having a smooth surface (of steel, col. 6, lines 32-33) and a second rigid cylinder 13 (of steel,

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col. 5, lines 44 and 53-55) having protuberances 16, 26 (col. 5, lines 19-21), the first and second cylinders defining a first nip therebetween, a pressure roller 18 having a resilient surface provided by a rubber coating 44 (col. 7, lines 28-30) that is less rigid than said first and second cylinders, the pressure roller and the second cylinder defining a second nip therebetween which is downstream of the first nip, means 41 for pressing the first cylinder and the second cylinder against each other, and means 47 for pressing the pressure roller and the second cylinder against each other. Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/73053 (Figures 1 and 8-10; page 9, line 25 through page 10, line 2).

WO 00/73053 discloses an embossing apparatus comprising a first rigid cylinder 10 and a second rigid cylinder 12 having protuberances 28, the first and second cylinders defining a first nip 16 therebetween, a pressure roller 14 having a resilient rubber surface that is less rigid than said first and second cylinders, the pressure roller and the second cylinder defining a second nip 18 therebetween which is downstream of the first nip. WO 00/73053 inherently discloses means for pressing the first cylinder and the second cylinder against each other and means for pressing the pressure roller and the second cylinder against each other. WO 00/73053 does not disclose that the first rigid cylinder has a smooth surface (claim 1), and does not disclose that the resilient surface of the pressure roll is provided by a rubber coating (claim 3). However, the use of a rigid embossing cylinder cooperating with a rigid smooth cylinder was well known and conventional in the embossing art, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify WO 00/73053 by providing the first rigid cylinder with a smooth

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surface cooperating with the embossing surface of the second rigid cylinder since such were equivalent means for embossing a web. Moreover, it would have been further obvious to a skilled artisan to have provided the resilient rubber surface of the pressure roller of WO 00/73053 as a rubber coating, as is conventional in the embossing art, in order to facilitate the manufacture of the pressure roller.

Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

16. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz (U.S. Patent 5,091,032; Figure 3).

Schulz discloses an embossing apparatus (Figure 3) comprising a first rigid cylinder 46 and a second rigid cylinder 48 having protuberances (col. 4, lines 45-49), the first and second cylinders defining a first nip 52 therebetween, a pressure roller 50 having a resilient rubber surface that is less rigid than said first and second cylinders (col. 4, lines 50-55), the pressure roller and the second cylinder defining a second nip 49 therebetween which is downstream of the first nip. Schulz inherently discloses means for pressing the first cylinder and the second cylinder against each other and means for pressing the pressure roller and the second cylinder against each other (note col. 4, line 61, and col. 5, lines 11-12). Schulz does not disclose that the

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first rigid cylinder has a smooth surface (claim 1), and does not disclose that the resilient surface of the pressure roll is provided by a rubber coating (claim 3). However, the use of a rigid embossing cylinder cooperating with a rigid smooth cylinder was well known and conventional in the embossing art, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Schulz by providing the first rigid cylinder with a smooth surface cooperating with the embossing surface of the second rigid cylinder since such were equivalent means for embossing a web. Moreover, it would have been further obvious to a skilled artisan to have provided the resilient rubber surface of the pressure roller of Schulz as a rubber coating, as is conventional in the embossing art, in order to facilitate the manufacture of the pressure roller.

Note that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Riemersma et al., WO 00/73053 and Schulz, as applied to claims 1 and 3 above, and further in view of Lefebvre Du Grosriez (U.S. Patent 6,475,346; Figure 1).

Each of Riemersma et al., WO 00/73053 and Schulz teach or suggest the embossing apparatus substantially as claimed, except for the protuberances of the second cylinder being arranged in longitudinal bands parallel to the cylinder axis and circumferential annular bands.



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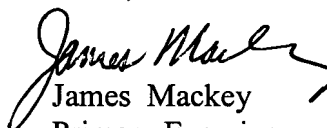
However, such is a known arrangement of embossing protuberances as disclosed in Lefebvre Du Grosriez, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify any one of Riemersma et al., WO 00/73053 and Schulz by providing the second embossing cylinder with such a known arrangement of embossing protuberances in order to form desired embossments in the product web.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
James Mackey  
Primary Examiner  
Art Unit 1722

5/11/07

jpm  
May 11, 2007